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Bryce A. Jones

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SPRINT COMMUNICATIONS COMPANY L.P.

6391 SPRINT PARKWAY

MAILSTOP: KSOPHT0101-Z2100

OVERLAND PARK, KS 66251-2100

EXAMINER

MERCHANT, SHAHID R

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYCE A. JONES, VON K. McCONNELL, and
CORREY TRUPP

Appeal 2009-002018
Application 09/997,946
Technology Center 3600

Decided:¹ July 23, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-24 and 26-32 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed a communications network which includes a subscriber terminal, such as a computer or cellular telephone, which may be granted access to a data network, such as the Internet, based on the balance of a prepaid account. If the balance meets a threshold (e.g., balance is less than or equal to threshold) traffic from the subscriber terminal may be directed to a self-service portal to add value to the prepaid account (Spec. 4:8-14). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method for providing prepaid data service to a subscriber terminal in a communications network coupled by a gateway to a data network, the method comprising:

making a determination of whether a balance of a prepaid account of a corresponding subscriber for the data service meets a threshold;

if the determination is that the balance of the prepaid account does not meet the threshold, then passing traffic to a requested destination in the data network;

if the determination is that the balance of the prepaid account meets the threshold, then redirecting the traffic to a self-service portal; and

adding value to the balance of the prepaid account at the self-service portal using the subscriber terminal.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Taskett	US 5,991,748	Nov. 23, 1999
Moore	US 2002/0046255 A1	Apr. 18, 2002
Lesley	WO 98/21874	May, 22, 1998
Berry	WO 99/56254	Nov. 4, 1999

Sprint PCS Services, “Three-Way Calling”, obtained July 2, 2007, http://web.archive.org/web/20010417023351/e12.sprintpcs.com/services/net_shop.html.

The following rejections are before us for review:

1. Claims 1-2 and 4-11 are rejected under 35 U.S.C. § 102(b) as anticipated by Lesley.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley and Berry.
3. Claim 12 is rejected under 35 U.S.C. § 103(a) as unpatentable over Taskett and Sprint².
4. Claims 13-16, 18-21, 23-24, and 26-30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley and Moore.

² The Examiner’s Answer acknowledges that claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Taskett and Sprint at page 21.

5. Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley, Moore, and Berry.

6. Claim 22 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley, Moore, and Taskett.

7. Claim 31 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley and Sprint.

8. Claim 32 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lesley, Sprint, and Moore.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-11 this issue turns on whether the preamble is considered a limitation in claims 1 and 11.

With regards to claim 12 this issue turns on whether Taskett discloses both a first data service and a second data service.

With regards to claims 13-24 and 26-32 this issue turns on whether Lesley discloses a separate “communications network” and “data network.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:³

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF1. Lesley discloses a method for prepaid telecommunications services in which if the prepaid value in a subscribers record is sufficient for the requested service, then service is authorized (Abstract).

FF2. Lesley discloses the system may be used with telephones (8:1-2).

FF3. Lesley at page 15, lines 15-30, and page 16, lines 9-28, does not disclose the use of a separate communications network and data network.

FF4. Lesley discloses that if the network request is to add prepayment to the subscriber's database that the network prompts the subscriber for the monetary amount which is then accordingly updated (16:8-15).

FF5. Taskett discloses a method for adding funds to a prepaid account. The consumer is issued a prepaid telephone card for accessing a host computer system and the other side of the card is credit card, debit card or the like. (Abstract).

FF6. Taskett in Fig. 3 and Col. 4:65-Col. 5:17 does not disclose separate first and second data services.

FF7. Taskett does not disclose making a first and second determination of the balance of a prepaid account to meet a respective threshold for both a first data service and a second data service.

FF8. Sprint discloses that if your service plan does not allow long distance, you will not be able to make a Three-Way Call to a destination outside your Local Calling Area.

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16.

ANALYSIS

Claims 1-11

The Appellants argue that the rejection of claim 1 is improper because Lesley fails to disclose a user accessing a data service in a data network in a communications network (Br. 7-8). The Appellants also argue that Lesley fails to disclose two individual networks coupled by a gateway (Ans. 7, Reply Br. 2). The Appellants further argue that Lesley fails to disclose making a determination of whether a balance of a prepaid account for a data service meets a threshold and redirecting of traffic to a self-service portal (Br. 7-8).

In contrast the Examiner has determined that a data network and communications network are equivalents of each other (Ans. 19). The Examiner has found Lesley to determine whether there is sufficient prepaid value to pay for the requested telecommunications service (Ans. 20).

We agree with the Examiner. Claim 1 only includes the limitation for “a communications network coupled by a gateway to a data network” in the preamble. Whether to treat a preamble as a limitation is a determination “resolved only on review of the entire[] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Catalina Mktg. Int’l Inc. v. Coolsavings.com, Inc.* 289 F.3d 801, 808 Fed. Cir. 2002 (quoting *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed.Cir.1989). “In general, a preamble limits the invention if it recites essential structure or steps, or if it is “necessary to give life, meaning, and vitality” to the claim. *Id.* (quoting *Pitney Bowes, Inc. v. Hewlett Packard-Co.*, 182 F.3d 1298 at 1305 (Fed. Cir. 1999)). “Conversely, a preamble is not limiting “where a patentee defines a

structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.” *Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 Fed.Cir.1997)). Here, the claim body defines a complete method and the use “in a communications network coupled by a gateway to a data network” recited in the preamble is only considered a statement of intended use and not considered a limitation to the claim. Lesley has disclosed that if the prepaid value in a subscribers record is sufficient for the requested service that then service is authorized (FF1). Lesley has disclosed that the system uses telephone services (FF2) which may be considered a “data service” since data would be transmitted to hear the voice signals. Lesley also discloses that if the network request is to add prepayment to subscriber’s database that the network prompts the subscriber for the monetary amount which is then accordingly updated (FF4) which serves as “redirecting traffic to a self-service portal” for increasing the prepaid value. For these reasons, the rejection of claim 1, and dependent claims 2-10 which the Appellants have not argued separately, is sustained. The Appellants have presented the same arguments for claim 11 and the rejection of the claim is sustained for the same reasons.

Claim 12

The Appellants argue that the rejection of claim 12 is improper because in Taskett and Sprint there is no teaching of data services or a data network coupled to a communications network by a gateway (Br. 9). The Appellants argue that without these elements there is no possible teaching in Taskett of monitoring account balance thresholds separately for two different data services (Br. 9).

The Examiner has determined that the Appellants have not defined data service, data network, or communications network and that data service may be a “phone call” (Ans. 21). The Examiner has determined that a data network and communications network are equivalents of each other (Ans. 21). The Examiner has also found that Taskett in Fig. 3 shows a telephone network coupled to a data network (Ans. 21).

We agree with the Appellants. Claim 12 specifically requires both a “first data service” and a “second data service.” Claim 12 also requires making an individual determination of the balance of the prepaid account to meet a respective threshold for each of the first and second data services. Regardless of whether the first and second data services are equivalents, claim 12 requires both a *first* and *second* data service which for which individual determinations of the balance of the prepaid account must meet a respective threshold. The portions of Taskett cited by the Examiner do not disclose separate first and second data services (FF6). Further, Taskett does not disclose making first and second determinations of the balance of a prepaid account to meet a respective threshold for both a first data service and a second data service (FF7) as claim 12 requires. For these reasons the rejection of claim 12 is not sustained.

Claims 13-24 and 26-32

The Appellants argue that the rejection of claims 13 and 30 is improper because in the Lesley and Moore references there is no teaching of a separate communication and data network with prepaid access (Ans. 9-10).

The Examiner has determined that a data network and communications network are equivalents of each other (Ans. 23). The

Examiner has found that Lesley at pages 15 and 16 discloses the cited claimed limitations (Ans. 23-24).

We agree with the Appellants. Claims 13 and 30 both require a separate “communications network” and “data network.” Regardless of whether a “communications network” and “data network” are equivalent, the claims require that both be shown. The portions of Lesley cited by the Examiner do not show a separate “communications network” and “data network” (FF2) as claims 13 and 30 require and the Examiner has not asserted that Morris does. For these reasons the rejection of claims 13 and 30, and dependent claims 14-24 and 26-29, is not sustained. The Appellants have presented the same arguments for claims 31-32 and for the same reasons given above the rejection of claim 31-32 is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-2 and 4-11 under 35 U.S.C. § 102(b) as anticipated by Lesley.

We conclude that Appellants have failed to show that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a) as unpatentable over Lesley and Berry.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a) as unpatentable over Taskett and Sprint.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 13-16, 18-21, 23-24, and 26-30 under 35 U.S.C. § 103(a) as unpatentable over Lesley and Moore.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over Lesley, Moore, and Berry.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 22 under 35 U.S.C. § 103(a) as unpatentable over Lesley, Moore, and Taskett.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 31 under 35 U.S.C. § 103(a) as unpatentable over Lesley and Sprint.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 32 under 35 U.S.C. § 103(a) as unpatentable over Lesley, Sprint, and Moore.

DECISION

The Examiner's rejection of claims 1-11 is sustained. The Examiner's rejection of claims 12-24 and 26-32 is reversed.

AFFIRMED-IN-PART

JRG

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